

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Daniel J. Fisher Examiner: Bryan R. Muller
Serial No.: 10/821,071 Group Art Unit: 3723
Filed: April 8, 2004 Docket No.: M120.253.101 / 59554US002
Due Date: January 17, 2009
Title: ATTACHMENT SYSTEM FOR A SANDING TOOL

REPLY BRIEF TO SECOND SUPPLEMENTAL EXAMINER'S ANSWER
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Mail Stop Appeal Brief – Patents
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Reply Brief Under 37 C.F.R. §41.41(b)

This Reply Brief is responsive to the Second Supplemental Examiner's Answer mailed November 17, 2008, and supports the Notice of Appeal filed on April 17, 2007 appealing from the final rejection dated January 17, 2007 of claims 1-9, 14, 15, 28-34, 37, 38, 41, and 42 of the above-identified application. Twenty-two claims remain for consideration.

The U.S. Patent and Trademark Office is hereby authorized to charge required fees or credits due to Deposit Account No. 50-0471 at any time during the pendency of this application.

Supplemental Reply Brief to Second Supplemental Examiner's Answer

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ARGUMENT

All arguments presented in Appellant's Appeal Brief and Reply Briefs are incorporated by reference herein. Further, Appellant responds to the Second Supplemental Examiner's Answer as follows.

I. FIRST GROUNDS OF REJECTION

A. Plain and Ordinary Meaning of Claim 28 Requires Co-Planar Attachment and Non-Attachment Exterior Boundaries

The Second Supplemental Examiner's Answer appears to contend that the "co-planar" limitation of claim 28 can be interpreted relative to any location along a thickness of the claimed attachment material (i.e., that "the plane" of the attachment surface is anywhere along the attachment material body). It is respectfully submitted that this interpretation improperly fails to give the claim terms their ordinary and customary meaning. *MPEP §2111.01*. In particular, claim 28 recites that the attachment and non-attachment surfaces are co-planar. A "surface" is ordinarily and customarily understood to be "the exterior or upper boundary of an object or body." *Merriam-Webster Online Dictionary*. The recitation in claim 28 that the attachment and non-attachment surfaces each terminate opposite the first major surface of the conversion pad confirms this understanding (e.g., that a "surface" is a termination boundary). Thus, claim 28 is correctly interpreted as requiring that the attachment exterior or upper boundary is co-planar with the non-attachment exterior or upper boundary. Kleemeier fails to disclose this configuration and thus does not anticipate claim 28.

Along these same lines, the Second Supplemental Examiner's Answer's argument that the intersection point of the fibers 16, 17 of the driving layer 15 with the resin layer 14 of Kleemeier serves as the "co-planar attachment surface" of claim 28 is incorrect. The internal point of intersection of the fibers 16, 17 is not a "surface" as that term is commonly understood. Instead, the free ends 16a, 17a of the fibers 16, 17 provide the exterior or upper boundary of the driving layer 15, and thus are the only feature of Kleemeier that can serve as the claimed "attachment surface". Further, claim 28 requires that the attachment surface is for attaching the

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conversion pad with an abrasive article; the enlarged heads 16a, 17a are what achieve attachment of the driving layer 15 to the abrasive article 20, not the point of intersection with the resin layer 14. This fact buttresses Appellant's position that only the free ends 16a, 17a can be viewed as "the attachment surface" relative to which the "co-planar" feature of claim 28 is relevant.

In summary, in applying Kleemeier to claim 28, it is improper to randomly select an arbitrary "plane" along a length of the individual fibers 16, 17 relative to the "co-planar" limitation. The Examiner's incorrect position that "the plane" of the claimed attachment surface can be designated anywhere along the claimed attachment material would effectively render the "co-planar" limitation meaningless. Instead, claim 28 requires that the attachment surface (i.e., exterior upper boundary) is co-planar with the non-attachment surface (i.e., exterior or upper boundary). Kleemeier does not teach at least these features.

B. Claim 28 Does Not "Only Read On" a Non-Elected Species

The Second Supplemental Examiner's Answer repeats previous statements that Appellant's argued positions cause claim 28 to read on non-elected species. Appellant believes that this argument has been sufficiently addressed. In summary, the previous Species Election Requirement did not reference any figures, nor did it delineate between co-planar and non-co-planar embodiments. Thus, the Examiner's concern is without basis.

II. SECOND GROUNDS OF REJECTION

The Second Supplemental Examiner's Answer argues that the requirement of claim 1 of "a non-attachment region ... forming an attachment with the associated mating surface that is weaker" (emphasis added) does not require any attachment, and encompasses a complete absence of material is incorrect. Regardless of the Examiner's current view on the propriety of claims 9 and/or 13 relative to the scope of claim 1, claim 1 unambiguously states that the non-attachment region can form an attachment. While this attachment is "weaker" than that formed by the claimed attachment region, a non-attachment region capable of forming at least some attachment is required. Kleemeier clearly does not teach this feature.

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III. THIRD-SIXTH GROUNDS OF REJECTION

Appellant reasserts all previous arguments traversing the remaining grounds of rejection.

CONCLUSION

For all of the reasons presented, removal of the rejections is requested.

Any inquiry regarding this Reply Brief should be directed to either David B. Patchett at Telephone No. (651) 736-4713, Facsimile No. (651) 736-3833 or Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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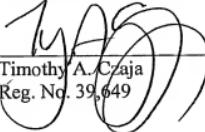
Respectfully submitted,

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